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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/684,057	10/06/2000	Stefan Johansson	15292.2	1607

7590 08/05/2004

Attn: DANA L. TANGREN
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EXAMINER

EDELMAN, BRADLEY E

ART UNIT	PAPER NUMBER
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2153

DATE MAILED: 08/05/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/684,057

Applicant(s)

JOHANSSON, STEFAN

Examiner

Bradley Edelman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 06 October 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) 31-34 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 06 October 2000 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
 - 2) ☐ Certified copies of the priority documents have been received in Application No. _____.
 - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input checked="" type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. <u>6</u> . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date <u>5</u> . | 6) <input type="checkbox"/> Other: _____. |

Interview Summary	Application No.	Applicant(s)	
	09/684,057	JOHANSSON, STEFAN	
	Examiner	Art Unit	
	Bradley Edelman	2153	

All participants (applicant, applicant's representative, PTO personnel):

(1) Bradley Edelman. (3) ____.

(2) Dana Tangren. (4) ____.

Date of Interview: 04 June 2004.

Type: a) ☒ Telephonic b) ☐ Video Conference
c) ☐ Personal [copy given to: 1) ☐ applicant 2) ☐ applicant's representative]

Exhibit shown or demonstration conducted: d) ☐ Yes e) ☒ No.
If Yes, brief description: ____.

Claim(s) discussed: all.

Identification of prior art discussed: ____.

Agreement with respect to the claims f) ☐ was reached. g) ☐ was not reached. h) ☒ N/A.

Substance of Interview including description of the general nature of what was agreed to if an agreement was reached, or any other comments: Examiner and Applicant's representative discussed the restriction requirement presented in the office action. Applicant's representative elected claims 1-30 for examination.

(A fuller description, if necessary, and a copy of the amendments which the examiner agreed would render the claims allowable, if available, must be attached. Also, where no copy of the amendments that would render the claims allowable is available, a summary thereof must be attached.)

THE FORMAL WRITTEN REPLY TO THE LAST OFFICE ACTION MUST INCLUDE THE SUBSTANCE OF THE INTERVIEW. (See MPEP Section 713.04). If a reply to the last Office action has already been filed, APPLICANT IS GIVEN ONE MONTH FROM THIS INTERVIEW DATE, OR THE MAILING DATE OF THIS INTERVIEW SUMMARY FORM, WHICHEVER IS LATER, TO FILE A STATEMENT OF THE SUBSTANCE OF THE INTERVIEW. See Summary of Record of Interview requirements on reverse side or on attached sheet.

Examiner Note: You must sign this form unless it is an Attachment to a signed Office action.

Examiner's signature, if required

DETAILED ACTION

This is a first Office action on the merits of this application. Claims 1-34 are presented for further examination. Because claims 31-34 are subject to a restriction requirement, as discussed below, they have been withdrawn from consideration.

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-30, drawn to a method for establishing a session between a wireless device and a wireless network system, classified in class 709, subclass 227.
 - II. Claims 31-34, drawn to a message data format, classified in class 709, subclass 230.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the connection establishment system of Group I, while it must use some kind of data format, does not require the particular data format claimed in the Group II claims. The subcombination has separate utility such as selecting which server from a group of servers to connect to.

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Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Group II, restriction for examination purposes as indicated is proper.

During a telephone conversation with Dana Tangren on June 4, 2004 a provisional election was made without traverse to prosecute the invention of Group I, claim 1-30. Affirmation of this election must be made by applicant in replying to this Office action. Claims 31-34 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

Specification

2. The title of the invention, "Data Transfer," is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed. Examiner suggests something similar to the following: "Establishing a Session Between a Network Server and a Mobile Communication Station."

The disclosure is objected to because of the following informalities:

On page 4, line 5, the word "hole" should read "whole."

In claim 15, the acronym "NSISDN" appears to be incorrect. It appears that it should read "MSISDN."

Appropriate correction is required.

Drawings

3. The drawings are objected to because Figures 1, 2, and 4 all include various numbered objects that do not include adequate labels or legends. An example is the object number 150 in Fig. 1, the object numbers 1-9 in Fig. 2, and the object numbers s1-s14 in Fig. 4. Corrected drawing sheets are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. The replacement sheet(s) should be labeled "Replacement Sheet" in the page header (as per 37 CFR 1.84(c)) so as not to obstruct any portion of the drawing figures. If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

Claim Rejections - 35 USC § 112

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

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4. Claims 1-30 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

a. Regarding claims 1 and 16, the phrase "such as" renders the claim indefinite because it is unclear whether the limitations following the phrase are part of the claimed invention. See MPEP § 2173.05(d).

Claims 2-16 and 17-23 depend from claims 1 and 16 respectively, and are thus rejected as well.

b. Regarding claim 24, the phrase "said network server" on line 5 of the claim lacks sufficient antecedent basis and is therefore unclear.

Claims 25-30 depend from claim 24, and are thus rejected as well.

c. Claims 16-23 are further rejected because the term "arrangement" in the preamble is ambiguous. It is not clear whether the "arrangement" refers to a physical system, a computer program product, a method, or some other entity.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

5. The claimed invention of claims 16-23 is directed to non-statutory subject matter because it is not clear whether the "arrangement" claimed is a process, machine, manufacture, or composition of matter, or whether the "arrangement" is something else, such as a pure computer program or an algorithm.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

6. Claims 1-4, 9-13, 16-19, 24, 25, 27, and 28 are rejected under 35 U.S.C. 102(e) as being anticipated by Winbladh (U.S. Patent No. 6,205,330).

Regarding claims 1 and 16, the phrase “such as a Global System for Mobile Communication...” in the preamble has been interpreted as merely suggestive of one type of possible platform on which the invention can run, and has thus been given no patentable weight. Note that Winbladh nonetheless discloses a system for use with a GSM communication network (see col. 3, line 43 and elsewhere).

In view of this interpretation, Winbladh discloses a method for initiating immediate transfer of packet data from a network server (“server 11”) to a mobile communication station (“MS unit 20”) over a digital radio communication network (“GSM” network, col. 7, lines 3-8; col. 3, lines 50-52, describing the use of the system in a data packet network; col. 6, lines 18-44, describing use over a TCP/IP system), including the acts of:

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Sending a message to the mobile communication station using a message service provided by the digital radio communication network ("SMS [message] is sent to the MS unit 20, "col. 7, lines 6-8), said message including a first packet data network address of said network server (col. 7, lines 7-8, 32-35, "SMS message is comprised of... a field 'DSG address (Data SMS Gateway Address)' containing the address and/or telephone number of the server 11 in which the intended e-mail has been stored");

Extracting the first packet data network address from the message by way of an application executing on the mobile communication station (col. 7, lines 58-61, "the communications software 46 reads the agent-part 48 of SMS and... calls the number in the 'DSG address,'" wherein the "DSG" address is the address of the server, col. 7, lines 31-35); and

Establishing, from the application of the mobile communication station having a second packet data network address (each mobile unit on the packet data network necessarily has an address), a packet data protocol session with said network server using said first packet data network address (col. 7, lines 61-62, "calls the number in the 'DSG address' 47 (start of a session)");

Whereby the network server is able to transfer packet data to the mobile communication station and the application using said packet data protocol session (col. 7, lines 63-67, "[server 11] commences the transmission of data in the same session").

In considering claim 2, Winbladh further discloses that the message service is SMS ("SMS," col. 7, line 7).

In considering claim 3, Winbladh further discloses that the first packet data network address is an IP address (col. 7, lines 4-5, 61-62, wherein the server is an "Internet GSM Smart Access Server" and thus uses an IP address).

In considering claim 4, Winbladh further discloses that the application performs the act of identifying the mobile communication station to the packet data service part of the digital radio communication network, if the mobile communication station is not identified to that service (col. 8, lines 23-33, wherein upon start-up at the beginning of a session, the mobile station software sends its number and a password to the server).

In considering claim 9, Winbladh further discloses that the application performs:

Examining an activation code present in the message received by the mobile communication station (col. 8, lines 55-56, "activation code [is] sent from the server 11 via an SMS"); and

Performing said act of identifying the mobile communication station to the radio communication network only if an appropriate activation was found in the message during the examining act (col. 8, lines 62-65, "manual insertion of the obtained code via the activation window activates the communications software 46 for the possibility of sending and receiving e-mail," or col. 9, lines 1-3, wherein activation is automatic).

In considering claim 10, Winbladh further discloses that the application performs:

Examining a service indication field ("field 'Code' 43," col. 7, lines 29-30); and
Presenting a message to a user of the mobile communication station the message being based on the content of the service indication field and describing the service that will be initiated (col. 8, line 62 – col. 9, line 8, wherein a "PIN code" is additionally entered by the mobile user to activate the service).

In considering claim 11, Winbladh further discloses that the message is a text message (col. 8, lines 54-55).

In considering claim 12, Winbladh further discloses that the application further performs the acts of:

Waiting for a reply to the presented message from the user of the mobile communication station (col. 8, lines 54-55, waiting for the user to enter the code); and

Continuing with, or aborting, said act of identifying the mobile communication station to the digital radio communication network in dependence on the reply to the presented message (col. 8, lines 56-57, wherein registration is confirmed in the correct code is entered).

In considering claim 13, Winbladh further discloses that the reply comprises an accept or deny reply (i.e. correct confirmation is an accept reply, and incorrect confirmation is a deny reply).

In considering claim 16, Examiner has interpreted the term "arrangement" as meaning "system." Winbladh discloses an arrangement at a mobile communication station ("MS unit 20") for facilitating immediate transfer of packet data from a network server ("server 11") to a mobile communication station over a digital radio communication network ("GSM" network), including:

First receiving means for receiving a message from a message service provided by the digital radio communication network, the message including a first packet data network address of said network server ("SMS [message] is sent to the MS unit 20, "col. 7, lines 6-8; wherein the "SMS message is comprised of... a field 'DSG address (Data SMS Gateway Address)' containing the address and/or telephone number of the server 11 in which the intended e-mail has been stored," col. 7, lines 7-8, 32-35);

Extracting means for extracting the first packet data network address from the message (col. 7, lines 58-61, "the communications software 46 reads the agent-part 48 of SMS and... calls the number in the 'DSG address,'" wherein the "DSG" address is the address of the server, col. 7, lines 31-35); and

Packet data protocol means for establishing a packet data protocol session ("session") with said network server using said first packet data network address (col. 7, lines 61-62, "calls the number in the 'DSG address' 47 (start of a session)"), and for receiving packet data from the network server addressed to a second packet data network address, which second packet data network address is allocated to the mobile communication station (col. 8, lines 53-61, wherein during the session, e-mails and

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other information are sent to the mobile station, which necessarily has a packet data network address since it is part of the packet data network).

In considering claim 17, Winbladh further discloses that the message service is SMS ("SMS," col. 7, line 7).

In considering claim 18, Winbladh further discloses that the first packet data network address is an IP address (col. 7, lines 4-5, 61-62, wherein the server is an "Internet GSM Smart Access Server" and thus uses an IP address).

In considering claim 19, Winbladh further discloses means for identifying the mobile communication station to the packet data service part of the digital radio communication network, if the mobile communication station is not identified to that service (col. 8, lines 23-33, wherein upon start-up at the beginning of a session, the mobile station software sends its number and a password to the server).

In considering claim 24, Examiner has interpreted the phrase "said network server" on line 5 as meaning "a network server." Interpreted as such, claim 24 presents a program storage device for performing the same steps as the arrangement of claim 16, and is thus rejected for the same reasons.

In considering claim 25, Winbladh further discloses that the message service is SMS ("SMS," col. 7, line 7).

In considering claim 27, Winbladh further discloses that the first packet data network address is an IP address (col. 7, lines 4-5, 61-62, wherein the server is an "Internet GSM Smart Access Server" and thus uses an IP address).

In considering claim 28, Winbladh further discloses the program storage device performing the act of causing the mobile communication station to identify itself to the packet data service part of the digital radio communication network, if the mobile communication station is not identified to that service (col. 8, lines 23-33, wherein upon start-up at the beginning of a session, the mobile station software sends its number and a password to the server).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

7. Claims 5-8, 14, 15, 20-23, 26, 29, and 30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Winbladh, in view of Lager et al. (U.S. Patent No. 6,636,502, hereinafter "Lager").

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In considering claims 5, 20, and 29, Winbladh further discloses that the step of identifying the mobile station to the packet data service of the digital communication network comprises an attach step if the device is not already attached (col. 8, lines 23-30, wherein if it is a new session, the mobile device sends its ID, a password, and other information to the service to identify itself). However, Winbladh does not disclose that the attach is a GPRS attach. Nonetheless, the inclusion of a GPRS system, including a GPRS attach within a GSM network is well known, as evidenced by Lager. In a similar art, Lager discloses a GSM system that allows a mobile device to set up a session with a network service, including a means for allowing the mobile device to attach to the network, wherein the system uses a GPRS attach (col. 3, lines 41-56; col. 7, line 64 – col. 8, line 30). Given this knowledge, a person having ordinary skill in the art would have readily recognized the desirability and advantages of incorporating the GPRS into the GSM system taught by Winbladh, because GPRS provides more effective use of scarce resources (see Lager, col. 1, lines 22-26). Therefore, it would have been obvious to incorporate the GPRS into the GSM system taught by Winbladh.

Claim 26 also describes that the GSM system uses GPRS, and is thus rejected under the same rationale as claims 5, 20, and 29.

In considering claims 6, 21, and 30, Winbladh discloses the claimed activation step of sending a request from the application to the network to activate a packet data service for the mobile communication station if the station does not have such a packet data service activated (col. 8, lines 23-34). However, Winbladh does not disclose the

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claimed steps of allocating a temporary network address as part of the activation step to the mobile communication station, wherein the temporary network address becomes the address used by the station for the station. That is because Winbladh assumes a static address for the device. Nonetheless, the GPRS system taught by Lager actually uses a temporary address assignment scheme. See Lager, col. 3, lines 46-57; col. 8, lines 6-30. It is advantageous to use temporary addresses for mobile devices in a GSM network, because temporary addressing allows for a larger number of systems to connect to the network. Therefore, it would have been obvious to use the temporary address assignment scheme taught by Lager to improve the scalability of the system taught by Winbladh.

In considering claims 7 and 22, Lager further teaches using GPRS Packet Data Protocol Context activation as the activation request (col. 3, lines 58-65; col. 6, lines 30-35; col. 8, lines 6-20).

In considering claims 8 and 23, Lager further discloses that the temporary network address is an IP address (col. 8, lines 6-20).

In considering claim 14, Lager further discloses the claimed ciphering step (col. 6, lines 10-20). It would have been obvious to include this in the system taught by Winbladh and Lager, in order to improve the security of the system.

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In considering claim 15, Lager further discloses that the identification number associated with the mobile station is a MS-ISDN number (col. 3, lines 21-22).

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bradley Edelman whose telephone number is (703) 306-3041. The examiner can normally be reached on Monday to Friday from 8:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Glen Burgess can be reached on (703) 305-4792. The fax phone numbers for the organization where this application or proceeding is assigned are as follows:

For all correspondences: (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Bradley Edelman

BE
July 30, 2004